1644
#11
Plunkett
8/12/99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of Pan Hong JIANG , et al.

Attorney Docket No. 040388/0113

Serial No. 09/077,606

Group Art Unit: 1644

Filed: July 30, 1998

Examiner: M. Tung

For: COMPOUNDS HAVING LECTINIC PROPERTIES AND THEIR BIOLOGICAL APPLICATIONS

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Office Action of July 16, 1999, the Applicants elect Group II with traverse.

The Examiner is requiring election of one of the following groups of claims:

Group I (claims 1-11, 37, and 38) drawn to nucleotide sequences encoding polypeptides having lectinic properties,
Group II (claims 12-22 and 25-32) drawn to polypeptides having lectinic properties,
Group III (claim 23, 24, and 34-36) drawn to antibodies specific to polypeptides having lectinic properties, and
Group IV (claim 33) drawn to use of polypeptides having lectinic properties in selecting inhibitors of lectinic activity.

PCT Rule 13.1 states that "[t]he international application shall relate to one invention only or to a group of inventions so linked as to from a single general inventive concept ('requirement of unity of invention')." Under PCT Rule 13.2, "the requirement of unity of invention ... shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

The requirement of unity of invention is fulfilled in the present application because "there is a technical relationship among [the inventions of Groups I-IV] involving one or more of the same or corresponding special technical features." Specifically, nucleotide sequences encoding polypeptides having lectinic properties (Group I), antibodies specific to polypeptides having lectinic properties polypeptides having lectinic properties (Group III), and the use of polypeptides having lectinic properties in selecting inhibitors of lectinic activity (Group IV), are all technically related to polypeptides having lectinic properties (Group II) as explained below.

The nucleotide sequences of Group I can be used to prepare the polypeptides of Group II, the antibodies of Group III can be used in the dectection of the polypeptides of Group II, and Group IV concerns the use of polypeptides of Group II in selecting lectin inhibitors. Thus, the "special technical feature" unifying the four inventions is that they are all related to polypeptides having lectinic properties.

The Examiner asserts that Groups I-IV lack the same or corresponding special technical features for two reasons. First, the Examiner states that "Groups I-III are unique products. They differ with respect to their structures and physicochemical properties and are therefore patentably distinct." The Examiner further states that "[t]he method of Group IV, drawn to selecting inhibitors of the lectinic activity of SCLs is distinct from the SCL peptides of Group II, in that it constitutes an additional recited use of the SCLs ...."

However, the Examiner gives no reasons as to why "unique products" having different "structures and physicochemical properties" and "an additional recited use of the SCLs" prevent the inventions of Groups I-IV from having a "technical relationship ... involving one or more of the same or corresponding special technical features." On the contrary, as explained above, the inventions of Groups I-IV are all technically related as required by PCT Rule 13.2.

Second, the Examiner states that "[b]ecause a search of any or [sic;of] these three [sic;four] inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the Examiner and because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper."

However, PCT Rules 13.1 and 13.2 say nothing of "serious undue burden on the Examiner" or "separate status in the art because of ... recognized divergent subject

matter." The Examiner has improperly attempted to apply U.S. rules regarding restriction practice to the U.S. national stage of a PCT application. The Examiner's second reason for requiring restriction is, in fact, not recognized under PCT practice.

The Applicants submit that the present invention is now in condition for allowance. Early notification of such action is courteously solicited.

Respectfully submitted,

August 3, 1999
Date

Thomas M. Rizzo
Thomas M. Rizzo, Ph.D.
Registration No. 41,272

FOLEY & LARDNER
Suite 500
3000 K Street, N.W.
Washington, DC 20007-5109
(202) 672-5300

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.